

Notice of Allowability

Application No.

10/646,919

Examiner

Karen Cochrane Carlson, Ph.D.

Applicant(s)

BARBAS, CARLOS F.

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to June 27, 2005.
2. ☒ The allowed claim(s) is/are 10 and 12-27.
3. ☒ The drawings filed on 21 August 2003 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

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This Notice of Allowability is in response to the paper filed June 27, 2005.

Applicant's election with traverse of Invention I, drawn to polypeptides comprising 2-4 nucleotide binding regions selected from the group consisting of SEQ ID NO: 32, 33, 34, 35, 36, and 37 in the reply filed on June 27, 2005 is acknowledged. The traversal is on the ground(s) that the Examiner has not met the burden for demonstrating the necessity for restriction. This is not found persuasive because the Examiner pointed out that the sequences differed in structure and in function and therefore are patentably distinct. Applicants also urge that Inventions I and II are overlapping in scope. In response, Claim 10 is drawn to a zinc finger nucleotide binding polypeptide comprising 2-6 nucleotide binding regions. Claim 11 is drawn to 2-12 zinc finger nucleotide binding polypeptides in a composition. The claims are wholly different, and will not be examined together. It is noted that Applicants acknowledge that the Inventions are patentably distinct at page 8.

Additionally, Applicants traverse the election of species. The restriction did not require an election of species. Specifically, the restriction pointed out that SEQ ID NOs: 17-110 differ in structure and in function. Therefore, these sequences are considered to be patentably distinct. Indeed, Applicants acknowledge that the peptides are patentably distinct at page 9-10.

The requirement is still deemed proper and is therefore made FINAL.

Claims 10-27 are currently pending. Claim 11 has been withdrawn from further consideration by the Examiner because this claims is drawn to a non-elected invention. Claim 10 and 12-27 are under examination.

The IDS Filed April 4, 2005 does not have a PTO 1449 or documents attached to it. Therefore, this IDS has not been considered. Applicants may wish to re-submit the PTO 1449 and associated documents for consideration.

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An **Examiner's Amendment** to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Michael B. Farber, Ph.D. on August 15, 2005.

Examiner's Amendments to the Claims:

10. (currently amended) An isolated and purified zinc finger-nucleotide binding polypeptide that contains from two to [about] 6 nucleotide binding regions, said nucleotide binding regions selected from the group consisting of the amino acid sequences depicted in SEQ ID NO: [17] 32 through SEQ ID NO: [110] 37.

11. (cancelled)

Examiner's Amendments to the Specification:

In the amendment to the specification filed August 21, 2003, at line 2, please insert between "2000" and "which" the following phrase: " --- , now U.S. Patent No. 6,610,512, ---.

The following is an **Examiner's Statement of Reasons for Allowance**: The prior art of record does not teach or suggest a zinc finger nucleotide binding polypeptide comprising 2-6 nucleotide binding regions selected from the group consisting of SEQ ID NO: 32-37. Therefore, the claims are allowable over the art of record.

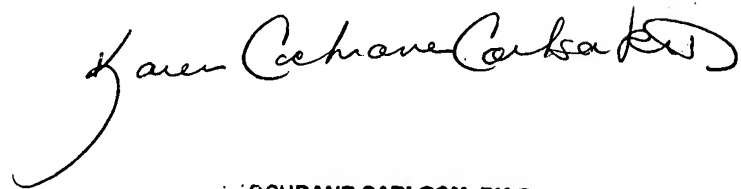
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Cochrane Carlson, Ph.D. whose telephone number is 571-272-0946. The examiner can normally be reached on 7:00 AM - 4:00 PM, off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KAREN COCHRANE CARLSON, PH.D.
PRIMARY EXAMINER

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